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10/540,963	07/10/2006	Franz Haimerl	FA/262	6053

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EXAMINER

PRANGE, SHARON M

ART UNIT	PAPER NUMBER
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3728

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,963	Applicant(s) HAIMERL, FRANZ	
	Examiner SHARON M. PRANGE	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 57-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/26/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 57-100 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/30/09.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 7,127,833.

Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the claimed structure of the present application may be wholly derived from the claimed subject matter of the patent.

Claim Objections

4. Claims 11, 14, and 22 are objected to because of the following informalities: Claims 11, 14, and 22 recite the limitation "the first connecting band" in lines 2-3, although only one connecting band has been previously recited. The limitation should state "the connecting band," as there are no subsequent connecting bands recited in the preceding claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 14 recites the limitation "at points of curvature of the lower end of the upper." This is vague and indefinite, because no curvature of the upper has been previously defined.

Claim 15 recites the limitation "the second connecting band" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the lining" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 19 and 20 recite the limitation "the second connecting band" in line 3. There is insufficient antecedent basis for this limitation in the claims.

Claim 41 recites the limitation "the second connecting band" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 48 and 49 recite the limitation "the porous first connecting band" in lines 3-4. There is insufficient antecedent basis for this limitation in the claims.

Claim 54 recites the limitation "the sealing material zone" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 56 recites the limitation "a waterproof functional layer" in line 2. This is vague and indefinite as a waterproof functional layer has been previously recited in claim 1, line 4. It is not clear whether this is the same waterproof functional layer as in claim 1 or a different one. For purposes of examination the waterproof functional layer of claim 56 is treated as a second waterproof functional layer.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-9, 13-30, 35-39, 43, 45-48, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahler (US 5,433,021).

Mahler discloses footwear having a shoe upper having a lower end. The upper has an outer material (upper 3) and a waterproof, water vapor-permeable functional layer (4). A lower end of the functional layer forms a functional layer zone that is not covered by the outer material. A connecting band (upper band 6, lower band 7, straps 8) extends around the periphery of the upper. The connecting band has an upper longitudinal side (6) joined to the outer material and a lower longitudinal side (7) joined to the functional layer. A liquid sealing material can flow through the band. A lining is arranged on the inner side of the functional layer. An insole (inner sole 1) is joined to the lower longitudinal side of the connecting band and the lining (column 5, lines 11-23; Fig. 1a). The connecting band may be substantially rigid (column 3, lines 35-38). The connecting band may be punched (column 6, lines 21-25). The connecting band may be formed by a net band, which may be woven (column 3, lines 61-62). The sealing material is formed by sole material which is liquid during the molding process and penetrates the connecting band (column 5, lines 24-32).

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Mahler does not specifically disclose the degrees of curvature of the upper and lower longitudinal sides of the connecting band. Mahler does teach the importance of having a pleat-free fabrication with the connecting band, particularly in areas with small radii of curvature (column 6, lines 30-37). It would have been a matter of obvious design choice to one of ordinary skill in the art at the time of the invention to have provided a smaller degree of curvature to one longitudinal side of the connecting band in order to eliminate any pleats within the band.

Regarding claims 6-9, Mahler discloses the claimed invention except for a second connecting band. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second connecting band in order to allow sealing material to flow more easily around all of the elements in the lower end, since such a modification would amount to a mere duplication of parts. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 26-28 and 45, Mahler does not disclose that the connecting band is subject to longitudinal tensile pre-stress. Official Notice is taken that it is old and conventional to attach a material while under tensile pre-stress to avoid any pleating of the material. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention, in view of the Official Notice, to have attached one end of the longitudinal band while under tensile pre-stress in order to avoid pleating of the material.

Regarding claim 45, Mahler discloses the general conditions of the claimed invention except for the express disclosure of the extendibility of the connecting band. It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the extendibility of the connecting band at least 20%, since the claimed values are merely an optimum or workable range. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

10. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahler, as applied to claims 1-9, 13-30, 35-39, 43, 45-48, and 51, in view of Keidel et al. (US 6,820,352), herein Keidel.

Mahler does not disclose that the lower end of the lining is longer than the lower end of the functional layer.

Keidel teaches providing a lining (10) which is longer than a functional layer (9) (column 3, lines 63-67; column 4, lines 1-12; Fig. 7-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the lining of Mahler shorter than the functional layer, as taught by Keidel, in order to allow the lining to be attached to the insole and/or connecting band without further puncturing the waterproof functional layer with seams.

11. Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahler, as applied to claims 1-9, 13-30, 35-39, 43, 45-48, and 51, in view of Ricosta GmbH & Co. (DE 296 01 600), herein Ricosta.

Mahler does not disclose a string-lasting tunnel with a lashing string.

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Ricosta teaches providing a string lasting tunnel (retaining loops) with a lashing string (pull cord 28) to the lower end of a liner (14) of a shoe. The lashing string allows the liner to be pulled tight over a last during molding of the sole. The tightening helps to prevent creasing of the liner within the shoe (page 8, para. 4, 5; page 10, para. 1; Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a string-lasting tunnel and lashing string, as taught by Ricosta, in order to allow the liner to be pulled tightly over the last during molding of the sole, preventing creasing within the shoe.

12. Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahler, as applied to claims 1-9, 13-30, 35-39, 43, 45-48, and 51, in view of Pavelescu et al. (US 5,943,791), herein Pavelescu.

Mahler does not disclose that the insole is connected to the functional layer, connecting band, or outer material by lasting cement or a Strobel seam.

Pavelescu teaches that it is well known to attach layers of the upper to the insole with either a Strobel seam or cement-lasting (column 4, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time of the invention to have attached the layers of the upper to the insole by either a Strobel seam or lasting cement, in order to use an attachment mechanism which is well known to be effective in attaching insoles.

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13. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahler, as applied to claims 1-9, 13-30, 35-39, 43, 45-48, and 51, in view of Haimerl (US 5,285,546).

Mahler does not disclose a sealing layer applied to the lower end of the upper.

Haimerl teaches providing a sealing layer (film 514c) to the underside of an upper such that it extends parallel to a still to be applied sole (column 10, lines 10-17; Fig. 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a sealing sheet, as taught by Haimerl, to the construction of Mahler in order to provide further waterproofing protection to the lower end of the shoe.

14. Claims 1-5, 13, 14, 16-18, 21, 22, 29-34, 43, 44, 46, 47, and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polegato Moretti (US 2002/0050537), herein Moretti, in view of Mahler.

Moretti discloses footwear having a shoe upper having a lower end. The upper has an outer material (upper 11) and a waterproof, water vapor-permeable functional layer (membrane 13). A lower end of the functional layer forms a functional layer zone that is not covered by the outer material. A connecting band (connecting element 20) extends around the periphery of the upper. The connecting band has an upper longitudinal side joined to the outer material and a lower longitudinal side joined to the functional layer. A lining (internal fabric 15) is arranged on the inner side of the functional layer. An insole (16) is joined to the lower longitudinal side of the connecting band and the lining (paragraphs 0027, 0030, 0032, 0033; Fig. 2). The connecting band

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is a non-porous material, having a sealing material (21) which melts with thermal energy, such as by the hot-liquid sole material. The band may be formed of polyurethane (paragraphs 0034, 0036, 0037). The functional layer is water-vapour-permeable and may be formed of PFTE (paragraph 0027). The insole may be joined by a Strobel seam (paragraph 0033).

Moretti does not specifically disclose the degrees of curvature of the upper and lower longitudinal sides of the connecting band. Mahler teaches the importance of having a pleat-free fabrication with the connecting band, particularly in areas with small radii of curvature (column 6, lines 30-37). It would have been a matter of obvious design choice to one of ordinary skill in the art at the time of the invention to have provided a smaller degree of curvature to one longitudinal side of the connecting band in order to eliminate any pleats within the band.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./ 3/13/10
Examiner, Art Unit 3728

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728